

## REMARKS

The present response cancels claims 27 and 36 and amends claims 2, 13, 21 and 30. No claims have been added. Therefore, claims 1-26, 28-35, 37 and 38 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### Section 102(b) Rejection:

The Office Action rejected claims 1-38 under 35 U.S.C. § 102(b) as being anticipated by Clark et al. (U.S. Patent 5,928,329) (hereinafter "Clark"). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, contrary to the Examiner's assertion, Clark fails to disclose a server, wherein the server is configured to generate a small device document in a format supported by the small device from a document in a format supported by the server. The Examiner first cites Clark column 14, lines 43-46:

Remote operation allows the user to obtain files from the host system not previously stored in the handheld computer H and allows access to the full resources available on the host computer.

Applicants assert that in neither this citation nor anywhere else does Clark disclose that the host system is configured to generate a document in a format supported by the small device from a document in a format supported by the server. In this citation, Clark simply discloses that the user of the handheld computer H may obtain files from the host system, and does not teach or disclose that the host system generates a file in a format supported by the handheld computer from a document in a format supported by the host system.

The Examiner next cites Clark column 10, line 16 through column 11, line 3. Again, applicants assert that in neither this citation nor anywhere else does Clark disclose that the host system is configured to generate a document in a format supported by the

small device from a document in a format supported by the server. Instead, in column 10, lines 37-47, Clark teaches a file viewer resident in ROM 114 of the handheld computer H (see Figure 5) that performs file conversions on files obtained from the host system:

A file viewer 226 is provided to allow viewing of files of particular types of common applications, such as word processor, spreadsheet and data base files. Preferably the number of file types supported is relatively limited, to reduce the size of the viewer 226, but preferably interchangeable elements are included to allow the user to customize the viewer supported file list to those frequently used. Preferably the viewer 226 also contains conversion software to convert unsupported file types to supported file types and graphic image presentation software if a conversion type is not available.

Thus, Clark clearly teaches in this citation and elsewhere that conversion of files from an unsupported file type to a supported file type is performed on files stored in the “handheld computer H” in the same format as is used on the host system by a “viewer” resident in ROM of the “handheld computer H”, and does not teach that file conversion from a format supported by the server to a format supported by the small device is performed in the server.

Further regarding claim 1, contrary to the Examiner’s assertion, Clark fails to disclose a server, wherein the server is...configured to synchronize the document in the format supported by the server with a modified version of the small device document on the small device. The Examiner first cites Clark column 6, lines 65-67:

These external units can either be connected to an individual host computer or can be connected to a server node of a network environment.

In this citation and in the paragraph from which the citation is extracted, Clark simply discloses that the handheld computer H may be connected via wireless circuitry to an “external unit” that may be connected to an individual host computer or to a server node of a network environment. Applicants assert that in neither this citation nor anywhere else does Clark disclose a server that is configured to synchronize the document in the format supported by the server with a modified version of the small device document on the small device.

The Examiner next cites Clark column 10, line 63 through column 11, line 3. Again, applicants assert that in neither this citation nor anywhere else does Clark disclose that the server is configured to synchronize the document in the format supported by the server with a modified version of the small device document on the small device. Instead, in column 10, line 63 through column 11, line 3, Clark teaches a synchronization module in ROM 114 of the handheld computer H (see Figure 5) that performs file synchronization of files between the handheld computer H and the host system:

One further module contained in the ROM 114 [of handheld computer H] is a synchronization module 238. This program...provides the capability to automatically synchronize the various files used in the computer H, such as the calendar 218, the phone directory 222 and the notepad 220 and any application software programs or miscellaneous files and directories which may be designated by the user with copies of the same files maintained in the host computer.

Thus, Clark clearly teaches in this citation and elsewhere that synchronization of files between the handheld computer H and the host system is performed by a synchronization module in the “handheld computer H”, and does not teach a server configured to synchronize a document in a format supported by the server with a modified version of the document in a format supported by a small device.

Applicants remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). For at least the reasons presented above, the rejection of claim 1 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 1 also apply to claim 12 and to amended claims 21 and 30.

In regard to claim 3, contrary to the Examiner's assertion, Clark fails to disclose that, to generate a small device document in a format supported by the small device from the document in the format supported by the server, the server is further configured to exclude one or more formats for content of the document in the format supported by the server from the small device document. The portion of Clark cited by the Examiner (col. 10, lines 44-47) refers to "conversion software to convert unsupported file types". However, claim 3 refers to "format for content" which is distinguishable from file types. For example, excluding format for content is different than converting a from one file type to another file type (e.g. converting from MS Word format to WordPerfect format). Format for content refers to how the content of the file is formatted, not the file type. Thus, the portion of Clark cited by the Examiner is not relevant to claim 3. Moreover, portions of Clark cited by the Examiner refer to functionality of the "handheld computer H", not a server. Similar arguments apply to claims 12, 23 and 32.

In regard to claim 4, contrary to the Examiner's assertion, Clark fails to disclose that, to synchronize the document in the format supported by the server with a modified version of the small device document on the small device, the server is further configured to restore one or more formats for content of the document in the format supported by the server excluded from the small device document. The portions of Clark cited by the Examiner mention absolutely nothing about restoring one or more formats for content of the document in the format supported by the server excluded from the small device document. Moreover, portions of Clark cited by the Examiner refer to functionality of the "handheld computer H", not a server. Similar arguments apply to claims 14, 24 and 33.

Regarding claim 8, contrary to the Examiner's assertion, Clark fails to disclose that, to synchronize the document in the format supported by the server with the modified version of the small device document, a server is configured to determine one or more differences between the modified version of the small device document and the document in the format supported by the server; and merge the determined one or more differences with content of the document in the format supported by the server to generate a

synchronized version of the document in the format supported by the server. As was pointed out in the remarks above regarding claim 1, Clark clearly discloses a synchronization process performed by a synchronization module in the “handheld computer H” and does not disclose a synchronization process performed in a server.

Thus, for at least the reasons presented above, the rejection of claim 8 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 8 also apply to claims 17, 21 and 30.

Regarding claim 9, contrary to the Examiner’s assertion, Clark fails to disclose that, to determine one or more differences between the modified version of the small device document and the document in the format supported by the server, the server is configured to generate a modified document in the format supported by the server from the modified version of the small device document; and compare the modified document in the format supported by the server to the document in the format supported by the server. The Examiner cites Clark column 15, line 60 through column 16, line 30. Applicants fail to see anywhere in that citation or elsewhere that Clark teaches that, to determine differences between the modified version of the small device document and the document in the format supported by the server, a modified document in the format supported by the server is generated from the modified version of the small device document and then compared to the document in the format supported by the server.

Applicants further note that, as was pointed out in the remarks above regarding claim 1 and claim 8, Clark clearly discloses a synchronization process performed by a synchronization module in the “handheld computer H” and does not disclose a synchronization process performed in a server.

Thus, for at least the reasons presented above, the rejection of claim 9 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 9 also apply to claims 18, 22 and 31.

Regarding claim 10, contrary to the Examiner's assertion, Clark fails to disclose that, to synchronize the document in the format supported by the server with the modified version of the small device document, the server is configured to generate a modified document in an interim format from the modified version of the small device document; [and] generate a document in the interim format from the document in the format supported by the server. The Examiner cites Clark column 13, lines 2-15. Applicants fail to see anywhere in that citation or elsewhere that Clark teaches that a modified document in an interim format is generated from a modified version of a small device document, and that a document in the interim format is generated from a document in the format supported by the server. Indeed, Applicants fail to see anywhere in Clark where Clark teaches or suggests the conversion of files into an interim format.

Further regarding claim 10, contrary to the Examiner's assertion, Clark fails to disclose that, to synchronize the document in the format supported by the server with the modified version of the small device document, the server is configured to determine one or more differences between the modified document in the interim format and the document in the interim format; and merge the determined one or more differences with content of the document in the interim format to generate a synchronized version of the document in the interim format. The Examiner cites Clark column 15, line 60 through column 16, line 30. Applicants fail to see anywhere in that citation or elsewhere that Clark teaches that, to synchronize the document in the format supported by the server with the modified version of the small device document, the documents are both converted to an interim format, and the two files in the interim format are compared to determine differences between the documents.

Applicants further note that, as was pointed out in the remarks above regarding claim 1 and claim 8, Clark clearly discloses a synchronization process performed by a synchronization module in the "handheld computer H" and does not disclose a synchronization process performed in a server.

Thus, for at least the reasons presented above, the rejection of claim 10 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 10 also apply to claims 19, 29 and 38.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

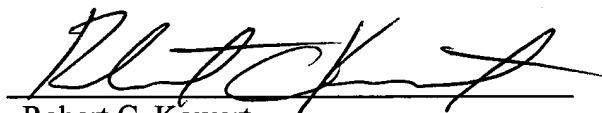
Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10500/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Fee Authorization Form authorizing a deposit account debit in the amount of \$  
for fees (        ).
- ☐ Other:

Respectfully submitted,



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